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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,238	08/02/2001	Benjamin Mosier	0468FV.044178	9707
35979	7590	02/22/2006	EXAMINER	
BRACEWELL & GIULIANI LLP P.O. BOX 61389 HOUSTON, TX 77208-1389			VIJAYAKUMAR, KALLAMBELLA M	
			ART UNIT	PAPER NUMBER
			1751	
DATE MAILED: 02/22/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,238

Applicant(s)

MOSIER ET AL.

Examiner

Kallambella Vijayakumar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 58-64, 72, 77, 80, 82, 84-86, 94-106 and 108-113 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 5, 9, 11-13, 16, 19-25, 32-38, 40, 44, 46-48 and 114 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 2,4,5,9,11-13;16,19-25,32-38,40,44,46-48,58-64,72,77,80,82,84-86,94-106 and 108-114.

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DETAILED ACTION

Status of the Claims: Claims 19, 38 and 114 were amended that overcomes the claim objection in the last office action. Claims 2, 4-5, 9, 11-12, 13, 16, 19-25, 32-38, 40, 44, 46-48, 58-64, 72, 77, 80, 82, 84-86, 94-106, 108-113 and 114 are currently pending with the application. Claims 58-64, 72, 77, 80, 82, 84-86, 94-106, 108-113 are been withdrawn from consideration due to the restriction requirement that was made final in the office action mailed 7/23/2004.

Applicant's reply filed January 3, 2006 has been fully considered, they are not persuasive, and fails to overcome the following rejections as set forth in the office action mailed 10/03/2005, because the applicants fail to distinguish their product by process and process claims over the prior art.

Claim Rejections - 35 USC § 102

Claim Rejections - 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 2, 4-5, 11, 13, 19-24, 32-33, 37, 38, 40, 44, 46-47 and 114 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sturwold (US 4,067,817).

The prior art teaches a lubricant composition obtained by the phosphoric acid (0.01-1%) catalyzed transesterification of triglycerides of castor oil <ricinoleic acid> with a polyoxyalkylene glycol <compound containing hydroxyl> in presence of a dicarboxylic acid <second component>. The reaction mixture comprised of 50-84 pts triglyceride, 2-36 pts glycol and 7-48 pts dimer acid and the transesterification was carried out at a temperature of 100-300°C. The compositions set forth in claims 2, 4-5, 11, 13, 19-24, 32, 37, 38, 40, 44 and 46-47 are anticipated because the reacting components, their composition and ratios, and the process conditions of the prior art are identical to that by the applicants (See Specification, Page-27) and identical processing of identical reactant composition will result in identical product, and If the product in the product-by-process claim is the same as the product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d

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695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). The glycerol is inherently produced by the acid catalyzed transesterification of ricinoleic triglycerides. The prior art further teaches addition of additives such as wetting agents and mineral oil to impart desired properties that meets the limitation of claims 33-34 (Col-5, Ln 21-35). This further meets the method of creating phosphorus-containing composition in claim-114. All the limitations of the instant claims are met.

The reference is anticipatory.

In the alternative that it be insufficient to arrive at the limitations of the instant claims, it would have been obvious to a person of ordinary skill in the art to optimize the process/ratio of components with reasonable expectation of success because the prior art teaches the varying of the component ratios and the process temperatures.

It is suggested to change the language in claim-114 by replacing the word 'creating' in line-1 with the word 'making' to better reflect the claim clarity.

2. Claims 9, 12, 25, 34-36 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sturwold (US 4,067,817) in view of either Haller (1907) or Klein (US 5,468,405).

The disclosure on the composition and method of making the lubricant by Sturwold as set forth in rejection-1 under 35 USC 102(b)/103(a) is here incorporated.

The prior art fails to teach the use of n-propanol in the transesterification of castor oil, and the addition of specific miscibility enhancing additives and their ratios per the claims.

In the analogous art of ricinoleic acid esters, Hart teaches transesterification of ricinoleic acid with methanol/ethanol/n-propanol/i-butanol in presence of hydrochloric acid (Page-465).

In the analogous art, Klein teaches the lubricant compositions containing dehydrated castor oils mixed with mineral oils, synthetic ester oils of dicarboxylic acids and natural esters such as triglycerides on the amount of 0-50% by wt (Col-2, Ln 36-54).

It would have been obvious to a person of ordinary skill in the art to combine the prior art teachings and optionally substitute the hydroxyl compound with n-propanol as functional equivalents and/or optionally include esters as additive and further optimize its ratio to benefit from desired properties with

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reasonable expectation of success because the combined prior art teaching is suggestive of the claimed composition. The presence of the specific compounds in the claims would be obvious because the reacting components, their ratios and the process conditions of the prior art are similar to that by the applicants (See Specification, Page-27) and similar processing of similar reactant composition is expected to result in similar product, and If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Response to Arguments

The instant claims are drawn to a composition containing a transesterified fatty acid ester (castor-oil/ricinoleic-acid ester) and a phosphorus containing compound produced by a process, and a method of making the composition. Applicants argue about the differences between their process of making the transesterified castor-oil/ricinoleic-acid and the prior art process by Sturwold, but fail to patentably distinguish their product-by-process composition and the method over the art compositions and methods (Response, Pages 15-19). Applicants further argue about the different mechanism of their process of forming the transesterified fatty acid ester, but fail to provide any evidence or documentation to show that the prior art process would not yield a transester of the ricinoleic-acid/castor-oil. *The transesterification process is known in the art as a method of making a different ester by exchanging an ester group with a different ester group in a compound (Hawley's Chemical Dictionary, 14th Edition, 2002).* The formation of the phosphated compound in presence of the phosphoric acid and castor oil will be anticipated in the reaction mixture of the prior art containing phosphoric acid.

Even if Sturwold is somewhat incorrect in using the term "transesterification", that the examiner believes both transesterification and esterification are taking place and therefore same product is obtained.

Applicants further argue that the prior art of Sturwold could not be combined with Haller et al because the Haller et al teaches alcoholysis and esterification is not persuasive because, the claims are drawn to a composition containing an ester of castor-oil, the prior arts teach compositions containing ricinoleic acid

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esters and a process of making the said composition, and one of ordinary skilled in the art would be motivated to combine the prior art teachings with reasonable expectation of success.

The process steps have not been given patentable weight, as the applicant is claiming a composition that may be made by any other process. Arguments or conclusionary statements unsupported by factual evidence are insufficient to establish unexpected results. See *In re Linder*, 173 USPQ 356 (CCPA 1972).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Wimmer (US 5399731) teaches the transesterification of oils including castor oil.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kallambella Vijayakumar whose telephone number is 571-272-1324. The examiner can normally be reached on 8-5.30 Mon-Thu, 8-4.30 Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KMV
January 26, 2006.


ROBERT J. WARDEN, SR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700